

## **REMARKS**

### **I. INTRODUCTION**

Claims 1 to 4 and 6 to 14 are now pending. Reconsideration of the present application in view of the foregoing amendments and following remarks is respectfully requested.

### **II. REJECTION OF CLAIMS 1 TO 4 AND 6 TO 14 UNDER 35 U.S.C. § 112, 1<sup>st</sup> ¶**

Claims 1 to 4 and 6 to 14 were rejected under 35 U.S.C. § 112, first paragraph regarding claim 1 with respect to the feature of “said dissipative coating layer is applied onto all connecting cables of ESD sensitive devices.”

Applicant respectfully disagrees with the merits of this rejection. Figure 2 illustrates a dissipative layer 4 applied on the top of an insulating layer 3, where the insulating layer 3 is coated on a copper trace 2. Figure 3 depicts a top view of a component, including a plurality of copper traces which are beneath an insulating layer and a dissipative layer. Those skilled in the art understand that the phrase “copper trace” refers to copper lines in a circuit that allow electricity to flow between electronic components. Similarly, those skilled in the art understand that “connecting cables”, as used in the context of the specification and claims, refer to copper traces. Accordingly, it is respectfully submitted that claim 1, as well as dependent claims 2 to 4 and 6 to 14, comply with the written description requirement under 35 U.S.C. § 112, first paragraph.

Claims 1 to 4 and 6 to 14 were also rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. As discussed above, a person of ordinary skill in the art would understand that the “copper traces” depicted in Figures 2 and 3 are the “connecting cables” referred to in claim 1. Accordingly, it is respectfully submitted that claim 1, as well as dependent claims 2 to 4 and 6 to 14, comply with the written description requirement under 35 U.S.C. § 112, first paragraph.

Withdrawal of the above rejections is respectfully requested.

### **III. REJECTION OF CLAIMS 1 TO 4 AND 6 TO 14 UNDER 35 U.S.C. § 112, 2nd ¶**

Claims 1 to 4 and 6 to 14 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As discussed above, a person of ordinary skill in the art would understand that the “copper traces” depicted in Figures 2 and 3

are the “connecting cables” referred to in claim 1. Accordingly, it is respectfully submitted that the claims fully comply with the requirements of 35 U.S.C. § 112, and withdrawal of this rejection is therefore respectfully requested.

#### **IV. OBJECTION TO THE DRAWINGS**

The drawings were objected to under 37 C.F.R. § 1.83 (a) for allegedly not showing every feature specified in the claims. In particular, the Office Action asserts that “the detail of dissipative coating layer applied onto all connecting cables of ESD sensitive devices, as claimed in the base claim 1, must be shown or the features(s) canceled from the claim(s).” As discussed above, a person of ordinary skill in the art would understand that the “copper traces” depicted in Figures 2 and 3 are the “connecting cables” referred to in claim 1. The copper traces are sufficiently illustrated in the figures and the specification.

Accordingly, withdrawal of this objection is respectfully requested

#### **V. REJECTION OF CLAIMS 1-4 AND 6-9 UNDER 35 U.S.C. § 102(b)**

Claims 1-4 and 6-9 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,350,594 (“Unruh”). Applicants disagree.

Claim 1 recites, in relevant part, an electrically conductive **copper trace** provided on said base. The Office Action admits that “traces and pad on board 10 made of copper clad laminate, not shown in figure except pad 32.” Applicants respectfully submit that the ground plane contact 32 does **not** describe a copper trace as recited in claim 1. As discussed above, copper trace connects components and allows electricity to flow, and is **not** equivalent to a ground plane contact 32.

Claims 2, 3 and 6-9 depend from claim 1, and are therefore allowable for at least the same reasons as claim 1.

#### **VI. REJECTION OF CLAIMS 10-14 UNDER 35 U.S.C. § 103(a)**

Claims 10 -14 were rejected under 35 U.S.C. § 103(a) as unpatentable over Unruh in view of U.S. Patent No. 6,459,043 (“Dodsworth”) and U.S. Patent No. 6,687,097 (“Anderson”).

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom,

Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)).

It is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the Dodsworth and Anderson references have not been asserted to and do not cure the critical deficiencies of the Unruh reference (as explained above) with respect to claim 1, from which claims 10-14 depend. It is therefore respectfully submitted that claims 10-14 are allowable for at least the same reasons as claim 1.

## **VII. REJECTION OF CLAIMS 1, 4, 6, 7, and 9-14 UNDER 35 U.S.C. § 103(a)**

Claims 1, 4, 6, 7, and 9-14 was rejected under 35 U.S.C. § 103(a) as unpatentable over Japanese Patent Publication No. 02-174289 (“Kawakami”) in view of the Dodsworth and Anderson references.

Claim 1 recites, in relevant part, an electrostatic discharge device (ESD) safe wireless type of component, which includes a base, an electrically conductive copper trace and an insulation layer, in which a dissipative coating layer applied onto the top of the insulation layer and all connecting cables of ESD sensitive devices.

As admitted on page 9 of the Office Action, the Kawakami reference does not in any way disclose or suggest the features of claim 1 with respect to a dissipative coating layer applied onto all connecting cables of ESD sensitive devices. It is respectfully submitted that the additional references do not disclose or suggest this feature.

The Dodsworth reference refers to an electrical shunt 150 that equalizes the static charge voltage between all leads 110. The Dodsworth reference does **not** describe or disclose the feature wherein said dissipative coating layer is **applied onto all connecting cables** of ESD sensitive devices. As discussed above, leads are not equivalent to copper traces/connecting cables.

The Anderson reference refers to a variably conductive material 180 which provides **good electrical contact** between the material 180, the pads 172, and/or the conductors 143. Column 7, lines 6-11. Therefore, the material 180 may **not** be a dissipative coating layer, as asserted by the Office Action, as it would merely conduct electricity to the pads 172 and/or the conductors 143.

Therefore, claim 1 is allowable over the cited references as applied.

Claims 4, 6, 7, and 9-14 depend from claim 1, and are therefore allowable for at least the same reasons as claim 1.

**VIII. REJECTION OF CLAIMS 2, 3, AND 8 UNDER 35 U.S.C. § 103(a)**

Claims 2, 3, and 8 were rejected under 35 U.S.C. § 103(a) as unpatentable over the Kawakami, Dodsworth and Anderson references in view of U.S. patent No. 5,350,228 ("Remington.")

It is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the Remington reference has not been asserted to and does not cure the critical deficiencies discussed above with respect to claim 1, from which claims 2, 3 and 8 depend. It is therefore respectfully submitted that claims 2, 3 and 8 are allowable for at least the same reasons that claim 1 is allowable.

**CONCLUSION**

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections be withdrawn since they have been obviated. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,



KENYON & KENYON LLP  
By: Richard M. Rosati  
Reg. No. 31,792  
One Broadway  
New York, NY 10004  
(212) 425-7200  
**CUSTOMER NO. 26646**

Dated: July 30, 2007